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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,578	02/27/2002	Takeshi Shibuya	ASA-1070	3832
24956 7590 04/10/2009 MATTINGLY & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
EXAMINER				
NAGPAUL, JYOTI				
ART UNIT		PAPER NUMBER		
1797				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,578

Applicant(s)

SHIBUYA ET AL.

Examiner

JYOTI NAGPAUL

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Amendment filed on January 21, 2009 has been acknowledged. Claims 16-25 are pending.

Response to Amendment

Rejection of Claims 16-18 and 21-25 as being anticipated by Mimura (US 6080364) has been modified in light of applicants' amendments/remarks.

Rejection of Claims 19-20 as being unpatentable over Mimura in view of Hanaway has been modified in light of applicants' amendments/remarks.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 16-18 and 21-25 rejected under 35 U.S.C. 102(b) as being anticipated by Mimura (JP 10-097754) (English translation provided in US 6080364).

Mimura teaches an automatic analyzer. The analyzer comprises an analysis unit (3) for analyzing specimens and a rack feed line (20) for transferring common racks **for holding patient specimens to be analyzed** and specific racks holding specific liquids **to be repeatedly sampled as needed for analysis** of the specimens from a rack supply section (75). With regards applicants' recitation "for holding patient specimens to be analyzed" is a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, Mimura teaches a rack feed line for transferring racks and is capable for holding patient specimens to be analyzed and specific racks holding specific liquids to be repeatedly sampled as needed for analysis of the specimens from a rack supply section (75) as recited by applicants'. The analyzer further comprises a rack standby disk (70) receiving the common and specific racks from the rack feed line (20), rotating and stopping in a state such that the plurality of common and specific racks are made to stand by thereon in a mixed state and a rack recovery line (25) for transferring the racks on the rack standby disk (70) towards a rack recovery section (18). The device further comprises a reading device/bar code reader (50) **for reading discriminating information fo the common and specific racks**. Further, a rack transfer means operating to transfer the common and specific racks from the rack standby disk to a specimen sampling position on an analysis unit and to return the common and specific racks, from which the specimens and specific liquids have been sampled in the specimen sampling position, to the rack standby disk (70). (See Col. 4, Lines 49-68- Col. 5, Lines 1-27) Mimura further teaches a control unit (40) **controlling transfer of the common and specific racks based on the discriminating information read by the reading device/bar code reader (5) so that the common rack is carried toward the rack recovery section (18) and the specific rack on the rack standby disk (70) is kept standing by on the rack standby disk (70) until a subsequent time of measurement with the specific rack**. With regards applicants' recitation "controlling

transfer of the common and specific racks based on the discriminating information read by the reading device/bar code reader (5) so that the common rack is carried toward the rack recovery section (18) and the specific rack on the rack standby disk (70) is kept standing by on the rack standby disk (70) until a subsequent time of measurement with the specific rack" is a recitation of the intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The rack standby disk (70) is disposed in a rack delivery unit. (See Figure 1) Mimura further teaches a position of the rack standby disk (70) for receipt of a pretreatment rack from the rack feed line (20) which a specimen is to be sampled and a position of the rack standby disk for carrying-out of an after treatment rack from which a specimen has been sampled are used in common. (See Col. 5, Lines 9-23) Additionally, with respect to Claim 21, applicant recites "wherein said control unit **controls** transfer of an emergency rack as one of the racks holding a specimen, **which** needs urgent measurement, said emergency rack being **received** by said rack standby disk, and when said rack standby disk **holds** the emergency rack, another one of the racks for which sampling and treatment of a specimen is **being performed** in said analysis unit, is **suspended and temporarily returned** onto the rack standby disk, wherein the emergency rack is **transferred** to the specimen sampling position of the analysis unit from the rack standby disk **after** the sampling and treatment of the specimen and wherein the **suspended** rack is then **transferred** to the specimen sampling position on the analysis

unit from the rack standby disk **so that** the sampling and treatment for the specimen are **resumed** for the suspended rack.” The above recitation is clearly a functional limitation. The language does not constitute a limitation in any patentable sense in apparatus claims. The control unit of Mimura is clearly capable of performing the claimed function as it is automated system. Mimura further teaches a control unit (40) controlling transfer of the racks in a manner that after a preceding rack is returned to the rack standby disk (70) from the specimen sampling position (4A or 4B), a subsequent rack is transferred via the rack transfer means.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mimura in view of Hanaway.

Refer above for the teachings of Mimura.

Mimura fails to teach the rack standby disk is disposed in an evaporating protecting chamber, in which air is maintained higher in humidity than an outside air.

Hanaway teaches a specimen tray assembly for use in an automatic analyzer. The assembly comprising of an evaporation protecting chamber (See Figures 2, 4 and 5).

It would have been obvious to a person of ordinary skill in the art to modify the device of Mimura such that the rack standby disk is disposed in an evaporating protecting chamber as suggested by Hanaway to achieve the predictable results of reducing evaporation and there is no undue evaporation of the contents of the cuvettes. (See Col. 7, Lines 28-31)

Response to Arguments

Applicant's arguments filed on January 21, 2009 have been fully considered but they are not persuasive. Applicants' argue that they have amended the claims to include

structural features, an analysis unit and a reading device, which are not disclosed by Mimura. Examiner respectfully disagree. Refer to the rejection above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI NAGPAUL whose telephone number is (571)272-1273. The examiner can normally be reached on Monday thru Friday (10:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JN

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797